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09/737,254	12/13/2000	James R. Woodhill	AUT6102P0011US	1903

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EXAMINER

NORRIS, TREMAYNE M

ART UNIT	PAPER NUMBER
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2137

10

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/737,254

Applicant(s)

WOODHILL, JAMES R.

Examiner

Tremayne M. Norris

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.6.9.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Objections***

1. Claims 21, 35, 36 are objected to because of the following informalities:

Regarding claim 21, there needs to be a space in between "20" and "wherein".

Regarding claims 35 and 36, the first indicium should be labeled as "first indicium" in order to distinguish it from the second indicium.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 42-46, 47-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear within claims 42 and 47 where the limitation of "additional executable instructions for establishing an address of the second terminal on the second network" is found or discussed within the specification.

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4. Claim 44 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear where it is taught that the "second terminal" comprises a telephone handset.

5. Claims 52-54 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations within claims 52-54 are not taught within the specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 32-36, 38 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "selected information" in claim 32 is a relative term which renders the claim indefinite. The term "selected information" is not

defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claim 32 should be re-written to clearly define what the "selected information" definitely is or what it is definitely referring to.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1-6,8-12,14-47,50,51 rejected under 35 U.S.C. 102(a) as being anticipated by Pickett (US pat 6,012,144).

Regarding claim 1, Pickett teaches a system comprising:

an electronic, packet switching communications network (col.2 line 66 thru col.3 line 1);

a user operable terminal for coupling a user to a displaced site on the network (col.3 lines 61-63);

pre-stored, executable instructions for establishing a telephone number for calling the user essentially immediately (col.4 lines 39-41);

pre-stored instructions for forming confirmation information and for transmitting same to the user terminal for display (figs. 3a-3c; col.5 lines 44-46);

pre-stored instructions for calling the user at the user's phone number via a public telephone network (col.4 lines 37-39);

pre-stored instructions requesting the user to provide at least the confirmation information during the call (col.4 lines 41-44; col.6 lines 5-10); and

pre-stored instructions for evaluating the identity of the user (col.6 lines 36-44).

Regarding claim 2, Pickett teaches executable instructions for creating and storing an audit trail for the transaction (col.4 lines 44-55).

Regarding claim 3, Pickett teaches executable instructions for providing a verbal request, during the call, that the user provide selected audio information for audit purposes (col.4 lines 36-47).

Regarding claim 4, Pickett teaches the establishing instructions include requesting a telephone number from the user for calling the user essentially immediately (col.4 lines 39-41).

Regarding claim 5, Pickett teaches the instructions for calling are executed while communicating with the user via the terminal (col.3 lines 57-60; col. 4 lines 37-39).

Regarding claim 6, Picket teaches includes instructions for transferring the user to evaluating software prior to calling the user (col.3 line 61 thru col.4 line 7).

Regarding claim 8, Pickett teaches the instructions for calling are executed while communicating with the user via the terminal (col.3 lines 57-60; col. 4 lines 37-39).

Regarding claim 9, Picket teaches the establishing instructions retrieve a pre-stored user phone number from storage (col.4 lines 14-20; col.4 lines 37-41).

Regarding claim 10, Pickett teaches a method comprising:

- establishing a bi-directional communications link between a visitor and a displaced software driven entity via a first electronic network (col.3 lines 55-57);
- obtaining an identifying indicium for the visitor for a second electronic network (col.4 lines 39-41);
- transferring confirmation information to the visitor, via the first network (figs. 3a-3c; col.5 lines 44-46);
- initiating a bi-directional communications link with the visitor via the second network (col.3 lines 57-60); and

transferring the confirmation information received by the visitor to the software driven entity via the second network (col.6 lines 5-10; col.6 lines 36-44);  
evaluating the received confirmation information at the software driven entity (col.4 lines 41-44; col.6 lines 36-44).

Regarding claim 11, Pickett teaches the first network is selected from a class which includes an Internet-type network and an intranet-type network (col.3 lines 55-57; col.8 lines 41-45).

Regarding claim 12, Pickett teaches the obtaining step comprises obtaining a telephone number from the visitor (col.4 lines 39-41).

Regarding claim 14, Pickett teaches the transferring step comprises transferring a numeric code as the confirmation information (col.4 lines 41-42).

Regarding claim 15, Pickett teaches the initiating step comprises selecting the public switched telephone network as the second network and, placing a telephone call to the visitor (col.3 lines 57-60).

Regarding claim 16, Pickett teaches providing directions verbally to the visitor via the bi-directional communications link of the second network (col.4 lines 3-7).



Regarding claim 17, Pickett teaches displaying the confirmation information for the visitor (figs. 3a-3c; col.5 lines 44-46).

Regarding claim 18, Pickett teaches obtaining a pre-stored telephone number for the user (col.4 lines 14-20; col.4 lines 37-41).

Regarding claim 19, Pickett teaches the first electronic network is selected from a class which includes an internet and an intranet (col.3 lines 55-57; col.8 lines 41-45).

Regarding claim 20, Pickett teaches a system comprising:

a first communication path for enabling a user to access at least one of a source of a selected product, a selected service, and a selected functional capability (col.3 lines 55-57); and

a second, different communication path for enabling the use, in response to communications on the first path, to respond to an inquiry initiated by the source using a predetermined station coupled to the second path and associated with the user (col.3 lines 57-60).

Regarding claim 21, Pickett teaches the first communication path is established intermittently by the user via a publicly accessible electronic packet switching network (col.3 lines 55-57).

Regarding claim 22, Pickett teaches the second communication path is established intermittently by the source via a different, publicly accessible switched network (col.3 line 1; col.3 lines 55-60).

Regarding claim 23, Pickett teaches the second communication path is established intermittently by the source via a different, publicly accessibly voice network (col.3 lines 55-60).

Regarding claim 24, Pickett teaches the second communication path is implemented using a publicly available switched telephone network (col.3 line 1; col.3 lines 55-60).

Regarding claim 25, Pickett teaches the station comprises a telephone (col.4 lines 3-7).

Regarding claim 26, Pickett teaches the first communication path establishes a link to a site on a digital network associated with the source (col.3 line 66 thru col.4 line 1).

Regarding claim 27, Pickett teaches the first communication path is established using an Internet service provider (col.3 line 66 thru col.4 line 1).

Regarding claim 28, Pickett teaches the user provides identifying information to the source using the first path (col.3 line 66 thru col.4 line 2).

Regarding claim 29, Pickett teaches the source transmits a message to the user to specify an identifier for the station (col.4 lines 39-41).

Regarding claim 30, Pickett teaches the source, responding to the identifier, initiates the second communication path using the identifier to specify the station (col.4 lines 2-7).

Regarding claim 31, Pickett teaches the source initiates a call to the telephone (col.4 lines 2-7).

Regarding claim 32, Pickett teaches the user uses the telephone, in response to the source to provide selected information to the source via the second communication path (col.4 lines 41-44).

Regarding claim 33, Pickett teaches the selected information is processed by the source to provide at least one of an authentication function (col.1 lines 29-31; col.4 lines 41-44), an authorization function and a collection function associated with the user (col.4 lines 15-20).

Regarding claim 34, Pickett teaches the source, in response to selected results of processing the selected information executes one of an authentication function and an authorization function (col.1 lines 29-31; col.4 lines 41-44).

Regarding claim 35, Pickett teaches the source transmits a graphically displayable indicium to the user via the first communication path (figs. 3a-3c; col.5 lines 44-46) and wherein the user, via the telephone transmits a second indicium to the source (col.4 lines 41-44; col.6 lines 5-10), wherein the source processes the received indicium and in response thereto executes one of the functions provided that the received indicium exhibits a predetermined characteristic (col.1 lines 29-32).

Regarding claim 36, Pickett teaches the indicium and the second indicium contain the same information (fig.3b step 5, col.6 lines 5-10).

Regarding claim 37, Pickett teaches an audit trail is created by the source (col.4 lines 15-20; col.4 lines 44-55).

Regarding claim 38, Pickett teaches an audit trail is created by the source along with executing the function (col.1 lines 29-32; col.4 lines 34-55).

Regarding claim 39, Pickett teaches a call is automatically placed to the telephone on behalf of the source and responses from the telephone are analyzed on behalf of the source (col.3 lines 58-60).

Regarding claim 40, Pickett teaches audit information is collected during the call (col.4 lines 34-55).

Regarding claim 41, Pickett teaches the source provides a communication function, and where the responses from the telephone exhibit a predetermined characteristic, the user will be provided access to the communication function (col.1 lines 29-32; col.4 lines 41-44).

Regarding claim 42, Pickett teaches a system comprising:

first and second electronic networks which are, at least in part; different (col.3 lines 55-60);

first and second terminals, physically adjacent to one another, with each terminal associated with a respective network (col.3 lines 55-60);

pre-stored, executable instructions for receiving an inquiry from the first terminal, via the first network (col.3 line 66 thru col.4 line 1);

additional executable instructions for establishing an address of the second terminal on the second network;

instructions for establishing a communications link, on the second network, with the second terminal (col.3 lines 57-60);

instructions for transmitting confirmatory information, via the first network, to the first terminal (figs. 3a-3c; col.5 lines 44-46);

instructions for receiving a representation of the confirmatory information, via the second network, from the second terminal (figs. 3a-3c; col.5 lines 44-46); and instructions for comparing the received representation to the transmitted information (col.1 lines 29-32; col.4 lines 41-44).

Regarding claim 43, Pickett teaches the second network comprises a switched telephone system (col.3 lines 57-58).

Regarding claim 44, Pickett teaches the second terminal comprises a telephone handset (col.4 lines 4-7).

Regarding claim 45, Pickett teaches the communications link of the second network is established simultaneously with another communications link using the first network (col.3 lines 55-60; col.3 line 66 thru col.4 line 7).

Regarding claim 46, Pickett teaches instructions for displaying the confirmatory information on the first terminal (figs. 3a-3c; col.5 lines 44-46).

Regarding claim 47, Pickett teaches an authorization system comprising:  
first and second electronic networks which are, at least in part;  
different (col.3 lines 55-60);

first and second terminals, with each terminal associated with a respective network (col.3 lines 55-60);

instructions for receiving an inquiry from the first terminal, via the first network (col.3 line 66 thru col.4 line 1);

instructions for establishing an address of the second terminal on the second network;

instructions for establishing a communications link, on the second network, with the second terminal (col.3 lines 57-60);

instructions for transmitting confirmatory information, via the first network, to the first terminal (figs. 3a-3c; col.5 lines 44-46);

instructions for receiving a representation of the confirmatory information, via the second network, from the second terminal (figs. 3a-3c; col.5 lines 44-46); and

instructions, responsive to the comparison indicium, for conducting an authorization process and for generating an authorization related indicium (col.1 lines 29-32; col.4 lines 41-44).

Claims 50 and 51 are substantially equivalent to claims 45 and 46 respectively, therefore claims 50 and 51 are rejected because of similar rationale.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pickett, and further in view of Civanlar et al (US pat 5,995,606).

Regarding claim 7, Pickett teaches a system as in claim 1, but does not teach instructions directing the user to sign off of the network prior to executing the instructions for calling the user. Civanlar teaches instructions directing the user to sign off of the network prior to executing the instructions for calling the user (col.6 lines 4-6). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Pickett's transaction security method with Civanlar's client-server architecture in order to make it possible to use the internet that may lack guaranteed quality of service, security, and flexibility with a public switched network that does offer these functionalities (Civanlar col.2 lines 33-40).



12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pickett.

Regarding claim 13, examiner takes official notice that alphanumeric codes are well known in the art. It would have been obvious for one of ordinary skill in the art at the time of the invention to implement the usage of alphanumeric codes in order to make it more difficult for a hacker to compromise the code.

13. Claims 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pickett, and further in view of Lim et (US pat 6,574,599).

Regarding claim 48, Pickett teaches a system as in claim 47, but does not teach the second network comprises a switched telephone system with a wireless portion. Lim teaches the second network comprises a switched telephone system with a wireless portion (col.2 lines 9-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Pickett's transaction security method with Lim's voice-recognition-based methods for outbound communication in order to permit a user to access various communication services that couples the use of the Internet and a public switch telephone network (Lim col.1 lines 60-63).

Regarding claim 49, Pickett and Lim teach the method of claim 48, in addition Lim teaches the second terminal comprises one of a land line and a wireless phone (col.2 lines 9-17).

Regarding claim 49, Pickett and Lim teach the method of claim 48, in addition Lim teaches the second terminal comprises one of a land line and a wireless phone (col.2 lines 9-17).

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tremayne M. Norris whose telephone number is (703) 305-8045. The examiner can normally be reached on M-F 7:30AM-5:00PM alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703) 305-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Tremayne Norris

July 8, 2004

  
MATTHEW SMITHERS  
PRIMARY EXAMINER  
Art Unit 2137